

## **REMARKS**

### **State of the Claims**

Claims 12-23 are pending. Claims 17-23 have been canceled without prejudice.

### **35 U.S.C. § 102(b) Rejection**

Claims 17-23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Applicants' admitted prior art.

Claims 17-23 have been canceled without prejudice. Therefore, the Examiner's rejection is now obviated.

Claims 17-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Koslow, et al. (U.S. Patent No. 5,922,803).

Claims 17-23 have been canceled without prejudice. Therefore, the Examiner's rejection has been obviated.

### **35 U.S.C. § 103 Rejection**

Claims 12-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art or Koslow '803 in view of Wallis, et al. (U.S. Patent No. 3,770,625). The Examiner asserts that both the Applicants' admitted prior art (APA) and Koslow '803 are structurally identical to Applicants' filter and that Wallis '625 teaches that similar activated carbon filters are capable of removing nano-sized pathogens from a liquid.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations.<sup>1</sup>

Applicants clarify that their claims claim both a filter capable of removing nano-sized pathogens and printed matter that communicates to a user that the filter may be used to remove nano-sized pathogens from a liquid in combination. Neither the APA in view of Wallis '625 nor Koslow '803 in view of Wallis '625 teach or suggest Applicants' combination.

Although Wallis '625 discusses the removal of viruses, Wallis '625 in combination with the APA or Koslow '803 does not teach or suggest adding printed matter that communicates to a

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<sup>1</sup> In re Vaack, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

user that the filter may be used to remove nano-sized pathogens from a liquid in combination with a filter that performs this function. Applicants respectfully assert that one of skill in the art would not be motivated by looking at the APA in combination with Wallis '625 or Koslow '803 in view of Wallis '625 to provide printed matter that communicates that a filter is capable of removing nano-sized pathogens. None of the references discuss or disclose the creation of printed matter for such a communication. In fact, none of the references even suggest the creation of printed matter to communicate any other kind of information to a user. A mere teaching of the removal of viruses in any of the references does not rise to the level of suggestion or motivation to create Applicants' printed matter, and to assert otherwise finds no basis in the references themselves or in the knowledge generally held by one of skill in the art.

When directed to a combination, printed matter in an article of manufacture claim is given patentable weight.<sup>2</sup> Without some teaching or motivation as to Applicants' filter in combination with printed matter, a prima facie case for obviousness cannot be properly made.

Therefore, Applicants respectfully request reconsideration and allowance of Claims 12-16 over the Examiner's 35 U.S.C. § 103(a) rejection.

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<sup>2</sup> In re Miller, 418 F.2d 1392 (CCPA 1969).



Appl. No. 09/574,456  
Amdt. Dated March 23, 2004  
Reply to Office Action of December 23, 2003

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### SUMMARY

The rejection in the Office Action has been discussed and, Applicants believe, the proper amendments have been set forth to address the rejection.

In light of both the amendments and the discussions contained herein, Applicants respectfully request reconsideration of the rejection and its withdrawal.

Issuance of a Notice of Allowance at an early date is earnestly solicited.

Respectfully submitted,

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March 23, 2004

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